

REMARKS REGARDING SUBMISSION OF DECLARATION OF PRIOR  
INVENTION UNDER 37 CFR 1.131

During a telephone Interview with Applicant's Representative, Examiner Myhre indicated that he believes that U.S. Patent No. 6,345,261 to Feidelson et al. ("Feidelson") discloses subject matter that in combination with one or more the currently cited references, specifically International Patent Publication No. WO 94/04979 A1 to Hartt et al. ("Hartt") and U.S. Patent No. 5,787,404 to Fernandez-Holmann ("Fernandez-Holmann") renders at least claim 1 of the present application unpatentable under 35 U.S.C. § 103(a). Although Applicant believes that the presently pending claims are patentable over Feidelson alone, or in combination with Hartt or Fernandez-Holmann, in order to expedite prosecution of the present application Applicant submits herewith documentation disqualifying Feidelson as prior art.

The present application was filed on November 1, 2000 claiming priority to U.S. Provisional Application No. 60/208,727 filed on June 2, 2000. Provisional Application No. 60/208,727 provides support for the present invention as defined in currently pending claims 1, 4-8, 11, 13-16, 24, 25, 29-32 and 49-55. Therefore, the effective filing date of the presently claimed invention is June 2, 2000.

The Feidelson patent issued on February 5, 2002, which is after the filing date of the present application of November 1, 2000. Therefore, Feidelson only qualifies as prior art under 35 U.S.C. § 102(e). The filing date of the Feidelson patent is September 30, 1999. In addition, the certificate of correction signed on December 24, 2002 indicated that the Feidelson patent claims priority to U.S. provisional application serial no. 60/135,450 filed on May 21, 1999. Therefore, assuming the provisional application provides sufficient support, the earliest possible effective filing date for the Feidelson Patent would be at best May 21, 1999.

However, the presently claimed invention was conceived **prior to May 21, 1999** and was constructively reduced to practice on June 2, 2000 by filing provisional application no. 60/208,727 on June 2, 2000. Further, the Inventor, as explained in the attached Declaration, diligently pursued reduction of this invention from prior to May 21, 1999 to the June 2, 2000 filing of the provisional application.

The invention as defined by currently pending claims 1, 4-8, 11, 13-16, 24, 25, 29-32 and 49-55, of which certain elements are alleged by the Examiner to be disclosed in the Feidelson reference, was conceived prior to the May 21, 1999 effective reference date of the Feidelson reference and diligently reduced to practice in the United States of America as indicated from the attached Declaration and documentary evidence.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Penny L. Caudle Reg. No. 46,607 at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this reply to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

Dated: November 25, 2008

Respectfully submitted,

By \_\_\_\_\_

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Docket No.: TFUND-4809  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
William C. O'Neil Jr. et al.

Application No.: 09/703,562

Confirmation No.: 3102

Filed: November 1, 2000

Art Unit: 3688

For: METHODS AND SYSTEMS FOR APPLYING  
REBATES TO HIGHER EDUCATION

Examiner: James Myhre

**DECLARATION UNDER 37 C.F.R. §1.131**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Madam:

I, Michael Thompson, do hereby declare that:

1. I am Chairman and CEO of TuitionFund, LLC, the assignee of the present application ("Assignee"). I am an inventor of the present application, and therefore have knowledge of the facts with regard to the conception and reduction to practice of the present invention.

2. I understand that the Examiner in charge of the above-identified application believes that U.S. Patent No. 6,345,261 to Feidelson et al. ("Feidelson") discloses subject matter that in combination with additional references may cause the Examiner to apply a rejection under 35 U.S.C. § 103(a) to at least claim 1 of the present application. I have reviewed the Feidelson reference and understand that Feidelson has an effective reference date of May 21, 1999.

Birch, Stewart, Kolasch & Birch, LLP

3. Prior to May 21, 1999, I conceived (on behalf of Alumni Publications, a predecessor company of TuitionFund, LLC) a rebate program and system designed to provide consumers with a convenient vehicle to help a) save for higher education expenses, b) make donations to institutions of higher learning, or c) pay off outstanding student loans through ordinary consumer purchases using registered debit and credit card accounts.

4. I invented a rebate system that included, *inter alia*, registration infrastructure for registering consumers purchasing accounts (e.g., credit or debit card/accounts), a designated higher education account, as well as participating merchant accounts; rebate management infrastructure for monitoring sales made by merchants to registered users, capturing qualifying transactions, and award the rebates offered by merchants to the users for accumulation in their designated higher education accounts; and an infrastructure for accessing various registered higher education accounts. I envisioned that the higher education accounts may include, *inter alia*, state 529 plans, educational IRAs, college fund savings accounts, college charitable contribution accounts, and existing student loan accounts. As corroborating evidence see pages 7-9 of the Alumni Publications LLC Business Plan which was prepared prior to the May 21, 1999 reference date of Feidelson, attached as Appendix A, which provides a conceptual overview of the rebate program.

5. As evidence of due diligence from prior to May 21, 1999 to the constructive reduction to practice on June 2, 2000 when provisional application no. 60/208,727 was filed, the following facts are provided:

(A) Prior to April 1999. I engaged representatives of Dye Van Mol, a public relations firm in Nashville, TN., to assist in designing and developing various components of an Alumni Publications/TuitionFund business plan and presentation relating to my rebate program concept. Preparation included conducting research on the projected cost of a college education, the amount of student loan borrowing, the projected growth of the internet and online commerce, and projected credit card spending volume. The resulting business plan went through various iterations, redrafting and proofing efforts prior to being finalized, printed and bound for future presentation.

(B) March – April, 1999. I began an initial skeletal design of a website which would function as a consumer/merchant interface for the Alumni Publication/TuitionFund concept. A functional version was expected to be completed in Fall 1999. In addition, I began researching possible companies, such as Infospace, who may be able to provide the infrastructure needed to track transactions and/or manage the rebate program, i.e., function as a rebate network manager.

(C) April 1999. Initial discussion with representatives of Fifth Third Bank to discuss possible business relationships between the TuitionFund system and Fifth Third Bank and its subsidiaries, including Fifth Third Processing Solutions, Fifth Third's subsidiary involved in debit and credit card transaction processing and providing other merchant services to retailers. A non disclosure agreement was signed on April 13, 1999.

(D) May 1999. I presented the rebate system concept to Edward Reilly of Big Flower Holdings, Inc. to discuss potential participants in the TuitionFund system and/or companies which could assist in providing system infrastructure. Edward Reilly signed a non-disclosure agreement dated May 14, 1999. In addition, I continued to research the ability of Infospace to function as the rebate network manager.

(E) June -July 1999. TuitionFund opened an office in Nashville, TN and began employing additional personnel to help implement the rebate program, for example, to interview merchants to discuss possible participation in the rebate program concept, to determine the infrastructure needed to implement functionality for both members and merchants, and to obtain feedback from merchants as to their possible interest in future participation in program. Conducted further research on IT and website development.

(F) June 15-30, 1999. I had discussions with various companies, for example, Staples, Best Buy, Big Flower Holdings, Inc., Walmart about possible participation in the rebate program. In addition, I spoke with LinkShare about possible participation of their consortium of on-line merchants in program.

(G) July 1999. I meet with a representative from AOL Interactive in Washington, DC about possible participation in TuitionFund rebate program.

(H) August 1999. I had various discussions with business, education, and legal experts to help identify possible investment instruments and the various regulations and legal ramifications of establishing/implementing particular investment instruments in the rebate program. The TuitionFund Educational Advisory Board which consisted of a number of university chancellors and representatives of college academia was formed. In addition, Lamar Alexander, former U.S. Secretary of Education, began providing advisory services to TuitionFund and helped TuitionFund establish its Educational Advisory Board.

(I) September 1999. I had discussions with representatives from Infospace regarding their on-line merchant network and their ability to function as the rebate network manager. I also had discussions with representatives of Vodafone and BellSouth/Cingular Wireless regarding the possibility of rebates being offered by cellular phone providers.

(J) October - December 1999. I utilized office space at the Nashville law offices of H3GM to begin developing and finalizing various program elements to be incorporated into the system, as well as the TuitionFund website.

(K) November 1999. Legal counsel conducts research regarding patentability of internet business methods and systems. Additional meeting with Fifth Third Bank representatives to discuss possible interface between the rebate program and Fifth Third Processing Solutions, Fifth Third's subsidiary involved in debit and credit card transaction processing and providing other merchant services to a large number of retailers.

(L) December 1999. Meeting with former principals of PMT Services, Inc., a bankcard processing company, to discuss card processing functions and how they would interface with the TuitionFund system. Also had discussions with representatives of Entandem Inc., consultants to the credit and debit card industry to discuss the feasibility of utilizing existing card processing infrastructure.

(M) January 2000. Had discussions with Galaxy.com of Nashville, TN. regarding design and development of TuitionFund website and interactive components needed to interface with merchants, members and card processors.

(N) February 2000. Legal counsel began drafting necessary legal disclosures and other matters regarding the rebate program to appear on the website, also researched various regulations and tax ramifications associated with crediting rebates into various investment instruments or toward educational debt accounts.

(O) March 2000. I met with Infospace to continue discussions regarding Infospace's ability to perform on behalf of TuitionFund the functions of rebate network manager. Patent counsel conducted research regarding filing a business method patent to cover methods and system design of the TuitionFund program.

(P) April 2000. Legal counsel begins drafting components of initial provisional patent application filed with the USPTO on June 2, 2000 and assigned patent application no. 60/208,727.

(Q) April 14, 2000. Met with representatives of Fidelity Investments to discuss possibility of Fidelity Investments being a money manager of TuitionFund program as they managed a number of state 529 plans.

(R) May 2000. I continued implementation of TuitionFund's systems, and infrastructure including , continuing work on patent application. I also met with Infinity Broadcasting, Univision, Fox Television, and Paramount Television in Los Angeles to discuss TuitionFund concept and possible future media opportunities. Met with representative of TIAA-CREF to discuss possibility of TIAA-CREF being a money manager for program as they managed a number of state 529 plans.

(S) June 2, 2000. Filed initial patent application 60/208,727 with USPTO on June 2, 2000.

6. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

NOV 24 2008 By Michael Thompson  
Date Michael Thompson

Enclosure: Alumni Publications, LLC Business Plan